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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,279	02/20/2002	Donald Jeffrey Boatwright		6622

7590 11/28/2003

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EXAMINER

FOSTER, JIMMY G

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 11/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/079,279

Applicant(s)

BOATWRIGHT, DONALD
JEFFREY

Examiner

Jimmy G Foster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Applicant is advised that the Notice of Allowance mailed August 1, 2003 is vacated. If the issue fee has already been paid, applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a specified Deposit Account.

2. Prosecution on the merits of this application is reopened on claims 1 and 2 considered unpatentable for the reasons indicated below in this Office action.

3. The Drawings are objected to as not including Figures 2A-2D as indicated on page 7 of Applicant's specification. If the specification continues to refer to these figures, these figures must be provided by Applicant in any response to this Office action in order for that response to be complete. No new subject matter that was not originally disclosed will be permitted.

4. Claim 1 is objected to because the limitation "so as to enable said card or cards to be removed and replaced means conveniently" (see part (e)) does not make idiomatic sense.

5. Claim 2 is rejected under 35 U.S.C. § 112, first paragraph since one of ordinary skill in the art would not be enabled to make the invention set

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forth in claim 2. More specifically, claim 2 requires a single integral piece, but claim 2 depends from claim 1 and is required by 35 U.S.C 112, fourth paragraph to be construed to include all of the subject matter of claim 1, including the pressure sensitive adhesive. It is not clear how to make the flat piece, the middle spacer pieces and the outer end cap pieces comprised of a single integral piece if the middle spacer pieces are connected to the flat piece by pressure sensitive adhesive and if the outer end pieces are connected to the middle spacer pieces by said adhesive.

6. Claim 2 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2, having an integral piece, appears to contradict claim 1 (which subject matter is a part of claim 2) which requires a connection the middle, end and flat pieces with pressure sensitive adhesive. Accordingly, it is unclear what subject matter is actually covered by claim 2.

7. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 1 and 2 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith (6,374,523 B1) in view of Vogeli, Sr (3,293,779) and Symonds (2,785,695). Applicant's claim 1 calls for an index card holding device attached to the surface of and object comprising (a) an inner flat plate as claimed, (b) two middle spacers, (c) two outer end cap pieces, (d) pressure sensitive adhesive connecting the flat plate to the object, (e) said outer end cap pieces and inner flat piece securing the card as claimed, and (f) the device being made of plastic or metal.

At the outset, it should be noted that Smith shows a holder for a sheet without discussion of dimension. However, in the discussion of the related prior art, the reference discusses holders for sports cards and photos (col. 1, line 56 through col. 2, line 9). Certainly index cards come in various sizes and would be capable of being mounted in a device such as Smith's. Smith shows an inner flat plate 20,22, two middle spacers 30 integral with two outer end cap pieces 32.

The fact that Smith shows these components as one piece, as opposed to multiple pieces which are adhered together as the instant claimed invention (claim 1), does nothing to patentably distinguish over the prior art. See Nerwin v. Erlichman, 168 USPQ 177 which refers to the equivalence of multiple pieces which form an integral unit and a single integral piece. Moreover, Figure 3 of Symonds, suggests using a pressure-sensitive adhesive/cement (27) for the purpose of attaching pieces (26,17) of a holder together. (Cement is inherently pressure sensitive at the time it is adhered.) Accordingly, it would have been obvious to one of ordinary skill in the art in view of all of

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this to make the single piece holder 16 of Smith from multiple pieces (20,22, 30, 32) adhered together by a pressure sensitive adhesive.

While Smith's Figure 4 appears to show some sort of adhesive (stippled layer) on the rear side 20 of the device, Smith is silent in his specification as to this feature. However, the reference of Symonds at 13 shows pressure sensitive strips for the purpose of attaching a card device to an object. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided pressure sensitive adhesive to Smith's holder in view of Symonds so that the holder can conveniently be attached to a surface such as a door (see Smith Fig. 1).

Although Smith also does not explicitly teach the use of plastic, except to refer to the back plate 16 as being "molded," the reference of Vogeli, Sr. teaches a card holder like that of the claimed invention may be made of a variety of materials including plastic (col. 1, lines 30-34). It would have been obvious to one of ordinary skill in the art to make the Smith's holder of plastic as taught by Vogeli, Sr since plastic is inexpensive, easy to keep to keep clean, and conducive to a molding process.

Regarding Applicant's claim 2, which claims the flat piece, the two middle spacer pieces, and the two outer end cap pieces as being formed as an integral piece of plastic, the reference of Smith clearly teaches an integral piece since the term "integral," by definition, is *that which makes something whole*.

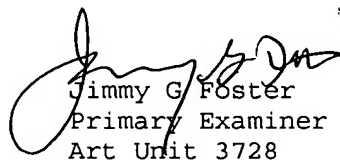
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy G Foster whose telephone number

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is (703) 308-1505. The examiner can normally be reached on Mon-Fri, 8:45 am - 5:15 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3579.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.


Jimmy G Foster
Primary Examiner
Art Unit 3728

JGF
24 November 2003